

Appl. No : 09/878,719
Filed : June 11, 2001

The first office action addressed claims 1-18, all of which had been cancelled prior to the issuance of the office action. Specifically, the filing transmittal sheet mailed on June 11, 2001 explicitly cancelled claims 2-18. Additionally, the Preliminary Amendment filed on August 16, 2001 cancelled Claim 1 and added claims 19-24. Subsequently, the Examiner mailed an office action on November 8, 2001 that addressed only claims 1-18, which were no longer pending. Accordingly, the office action mailed on June 4, 2002, was the *first* action that addressed the pending claims, and therefore, should not be considered a second, and final, action on the merits. Accordingly, Applicant respectfully requests withdrawal of the finality of the office action as premature.

Should the Examiner disagree with the Applicant's argument that the office action mailed June 4, 2002 should not have been made final, Applicant respectfully requests that the Examiner enter the accompanying declaration in anticipation of an appeal.

Rejections under 35 U.S.C. § 102(b)

Claim 25 is rejected under 35 U.S.C. § 102(b) as being anticipated by Henderson and also by Plus. Applicant respectfully disagrees with the Examiner's characterization of both the Henderson and Plus references. Specifically, the Examiner states that the groove of Henderson "extends to inherently form a scrotum channel." Moreover, the Examiner states that Plus has a groove that "extends to inherently form a scrotum channel." While the saddles of Henderson and Plus appear to each form a groove, their respective grooves are not configured to provide the advantages of the present invention, as discussed in the accompanying declaration. Moreover, independent Claim 25 recites additional limitations of the groove that are not met by either of these references. For instance, Claim 25 recites, *inter alia*, a groove that "provides an open space for relieving pressure on the pudendal arteries." As noted in the accompanying declaration, the grooves of both the Henderson and Plus saddles are too narrow and are thus inadequate to meet at least this limitation of Claim 25, and therefore, do not anticipate Claim 25.

Rejections under 35 U.S.C. 103(a)

Claim 26 is rejected under 35 US.C. 103(a) as being unpatentable over Wheeler in view of Henderson and further over Wheeler in view of Plus. Neither Wheeler, Henderson, or Plus teach or suggest the unique combination of features presented in Claim 26, nor is there any

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motivation to combine the references to result in the claimed saddle. As noted in the accompanying declaration, neither the Wheeler, Henderson, or Plus references teach a saddle having the claimed features. Specifically, the Henderson patent discloses a saddle with a central depression that, given the apparent scale of the drawing, appears to be approximately $\frac{1}{2}$ inch wide at a location midway between the front end and the back end of the frame. The Wheeler patent discloses a saddle with a central groove that, given the apparent scale of the drawing, is approximately .75 inches to 1 inch at the rear, and then widens before it narrows to the leading edge. The Plus saddle shows a groove that is far too narrow and short to result in the claimed saddle.

The saddles of Henderson, Wheeler, and Plus do not result in the claimed saddle, nor is there any motivation to combine the references to result in the claimed saddle. While the Examiner contends that a change in size is generally recognized as being within the level of ordinary skill in the art, the claimed saddle configuration is not merely an obvious change in size; but rather, is the result of a medical study carried out to identify and alleviate the causes of male infertility problems caused by conventional bicycle saddles. Moreover, the design and production of bicycle saddles has spanned three centuries, yet not a single saddle has been produced having the configuration, features or advantages of the claimed saddle. The claimed features, particularly the configuration of the central groove, is critical to practice the claimed invention, and none of the cited references, either alone or in combination, teach a saddle having the characteristics and advantages of the claimed saddle.

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CONCLUSION

In light of the foregoing, Applicant respectfully requests reconsideration of the pending claims. In addition, Applicant requests entry of the accompanying declaration and withdrawal of the finality of the Office Action mailed on June 4, 2002. Finally, Applicant respectfully submits that the pending claims overcome the prior art of record and requests an immediate notice of allowance. Should there be any questions or issues that could be resolved via a telephone conversation, Applicant invites the Examiner to contact the undersigned at the number shown below. Please charge any additional fees, including any fees for additional extensions of time, or credit overpayment, to Deposit Account No. 11-1410.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: November 12, 2002

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